REMARKS

I. Introduction

Claims 19-37 remain pending in this application and have been finally rejected. Applicants have amended claims 19, 30, 31, 33 and 36.

II. Rejection under 35 U.S.C. 112, Second Paragraph

With respect to claim 30, the Examiner indicated in the final Office Action that "[w]hat is realized is an encoding, decoding and transmitting location information," and that the body of the claim doesn't relate to "method of formatting data." While Applicants do not agree with the Examiner's contention, in order to obviate the Examiner's contention Applicants have amended claim 30 to recite a "method of at least one of electronically **encoding, decoding and transmitting location information** of objects . . . ."

For at least the foregoing reason, withdrawal of the rejection is requested.

III. Rejection under 35 U.S.C. 101

Claims 19-37 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

With respect to the independent method claims 19 and 30, the Examiner contends that these claims are "directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur," and that the "steps are not used to produce useful and **tangible result**, whether their execution accomplishes a practical application." Applicants respectfully note that the Examiner's rationale is based on an incorrect understanding of the applicable law, as explained in detail below.

First, it is patently clear that claims 19 and 30 are not "directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur"; instead, claims 19 and 30 clearly indicate **method steps** for operating on electronic information, i.e., amended claim 19 recites "at least one of electronically **encoding, decoding and transmitting** an electronic **data packet containing location information of at least one object for a map** by one an encoder, decoder and transmitter/receiver," and amended claim

30 recites "method of at least one of electronically **encoding, decoding and transmitting** location information of objects for a map by one an encoder, decoder and transmitter/receiver, the method comprising: providing an electronic **data packet including location information of at least one object for a map**."

In addition, to the extent the Examiner contends that the recited "steps are not used to produce useful and **tangible result**," the Examiner appears to be contending that a claimed invention must produce a useful and **physical result**. With respect to the issue of physical result, Applicants respectfully submit that "tangible result" (i.e., physical result) is **not a requirement** for satisfying 35 U.S.C. 101: as explicitly indicated by the Court of Appeals for the Federal Circuit, it is "**a misunderstanding of our case law**" to contend that **physical result** is necessary. See AT&T Corp. v. Excel Communications Inc., 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999). In fact, the Court of Appeals for the Federal Circuit further indicated that an inquiry regarding physical result is unnecessary "[s]ince the claims at issue in this case are **directed to a process** in the first instance." Id., at 1452. Furthermore, to the extent the Examiner is contending that no "useful result" is produced because the present claimed steps involve operations of electronic data, the Court of Appeals for the Federal Circuit has unequivocally stated that operations of electronic data is "**useful and tangible result**." See, e.g., AT&T Corp., at 1452; State Street Bank & Trust Co. v. Signature Financial Group, Inc., 47 U.S.P.Q.2d 1596, 1601-1602 (Fed. Cir. 1998). Applicants note that the above-recited decisions by the Court of Appeals for the Federal Circuit provide a clear legal foundation for a multitude of recently-issued U.S. patents include claims directed solely to method steps involving operation on electronic information (see, e.g., U.S. Patents 7,103,019; 7,085,282; 7,106,757; 7,120,253; 7,127,619; 7,131,049; 7,134,143; 7,174,499; 7,167,108; and 7,161,937). Accordingly, the Examiner is clearly incorrect in contending that claims directed solely to method steps involving operation on electronic information do not satisfy the requirements of 35 U.S.C. 101.

With respect to claims 31, 33 and 36, which recite "an encoding device," "a decoding device," and "a system," respectively, the Examiner contends that "the claims are not statutory, directed to software, per se, lacking storage on a medium, which enable any underlying functionality to occur," and that the "steps are not used to produce the useful and tangible result, whether their execution accomplishes a practical application." First, Applicants respectfully submit that there is **no reasonable interpretation** of the claim

language that would support the Examiner's contention that the claimed subject matter is "directed to software, per se," since "a device" and "a system" are clearly tangible subjects. The structural nature of the subject matter recited in claims 31, 33 and 36 is further evidenced by the explicit recitation of "an arrangement" in the body of the claims, i.e., claim 31 recites "an arrangement to electronically encode"; claim 33 recites "an arrangement to electronically decode"; and claim 36 recites "an arrangement to electronically encode, decode." Applicants respectfully submit that the subject matter of amended claims 31, 33 and 36 is clearly directed to a structural device/system, and there is no way that these claims can be interpreted as merely "directed to software, per se."

Independent of the above, to the extent the Examiner contends in connection with claims 31, 33 and 36 that the recited "steps are not used to produce **useful and tangible result**," presumably because the recited steps involve operations on electronic information, Applicants submit that the above-noted explanations regarding the "useful and tangible result" issue presented in connection with claims 19 and 30 are similarly applicable to claims 31, 33 and 36..

For at least the foregoing reasons, Applicants submit that claims 19, 30, 31, 33 and 36, as well as dependent claims 20-29, 32, 34-35 and 37, are in compliance with 35 U.S.C. § 101.

IV. Rejection under 35 U.S.C. 102(e)

Claims 19, 28-31, 33 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,044,323 ("Yee"). It is respectfully submitted that the claims 19, 28-31, 33 and 36 are not anticipated by Yee for at least the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary

skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In the "Response to Arguments" section of the Office Action (p. 4), the Examiner contends that "claims 19, 30, 31 and 33 . . . [do] not clearly [state] the location information is for location information of objects for a map," and that claim 36 does not recite "location information of objects for a map." Although Applicants submit that the claim language implicitly indicate that "the location information is for location information of objects for a map," Applicants have amended claim 19 to explicitly recite this feature in order to expedite the prosecution. Amended claim 19 recites the following:

> 19. A method for at least one of electronically encoding, decoding and transmitting **location information of objects for a map**, the method comprising:
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> at least one of electronically encoding, decoding and transmitting an electronic data packet containing location information of at least one object for a map by one an encoder, decoder and transmitter/receiver, the **location information of at least one object including locating information and description information, wherein the data packet** separately contains the locating information and the description information, and **includes assignment information** for assigning at least a part of the locating information to at least a part of the description information.

Independent claims 30, 31, 33 and 36 recite features substantially similar to the above-recited features of claim 19, i.e., "providing an electronic data packet including **location information of at least one object for a map, wherein the location information of at least one object** includes locating information and description information, **wherein the data packet** separately contains the locating information and the description information, and **includes assignment information** for assigning at least a part of the locating information to at least a part of the description information." In Applicants' claimed invention, the "location

information" specifically refers to "location information of objects for a map," and the "**location information**" clearly includes **three component** information, i.e., the **locating information**, the **description information**, and the **assignment information**. Applicants respectfully submit that Yee does not teach or suggest these claimed features, as explained in detail below.

In support of the rejection, the Examiner cites Fig. 3 and col. 6, l. 60 – col. 7, l. 24 of Yee as disclosing the claimed limitations of "**location information of objects for a map,**" which includes the locating information, the description information, and the assignment information. However, the actual disclosure of Yee clearly does not teach or suggest the claimed limitations, as explained in detail below.

Fig. 3 of Yee shows the data format for carrying messages, which format includes a header 82, a routing code 84, a subscriber ID 86 and message data 88. According to col. 7, l. 5-10 of Yee, the header, the routing code and the subscriber ID are overhead data, whereas the message data includes either system control data, or system control data together with subscriber traffic. The data packet disclosed in Yee is a data packet for carrying messages (see, e.g., col. 2, l. 35-37), and the data packet of Yee has nothing to do with "location information of objects for a map" as recited in the present claims.

Independent of the above, the Examiner's contention that the claimed "**locating information**" is taught by Yee's "data packet and its destination" is completely incorrect: the destination of a data packet, i.e., where the data packet has to go, has nothing to do with the claimed "locating information of an object for a map," i.e., where an object is. To the extent the Examiner is implicitly contending that "locating information" may be construed broadly to encompass "destination," this interpretation is clearly and completely out of line with the ordinary meaning of "locating."

In addition, the Examiner's contention that the claimed "description information" is taught by Yee's "subscriber ID and subscriber traffic" is clearly incorrect. In the present claims, "description information" is an additional content of the "location information," which "description information" is separate from the "locating information." In contrast, Yee clearly does not teach or suggest two different contents in the data packet; instead, the subscriber ID of Yee is merely a number representing the subscriber, and the subscriber

traffic is just the message content (see, e.g., col. 7, l. 16-18), i.e., there is just one message content.

Furthermore, to the extent the Examiner contends that the claimed "assignment information" limitation is taught by Yee's "packet that carries subscriber traffic to route such packet 80 to the traffic channels assigned to the identified subscriber unit 92)," this contention is incorrect. In contrast to the present claimed invention which clearly requires "assignment information for assigning at least a part of the locating information to at least a part of the description information," Yee clearly does not provide assigning the destination of the data packet (the Examiner's asserted equivalent of the claimed "locating information") to the subscribed ID and subscriber traffic (the Examiner's asserted equivalent of the claimed "description information").

For at least the foregoing reasons, there is no reasonable interpretation of Yee that would support the Examiner's anticipation rejection of claims 19, 30, 31, 33 and 36, as well as dependent claims 28-29.

V. Rejection under 35 U.S.C. 103(a)

Claims 20-27, 32, 34, 35 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yee in view of U.S. Patent No. 6,169,515 ("Mannings"). It is respectfully submitted that the claims 20-27, 32, 34, 35 and 37 are not rendered unpatentable by the combination of Cotter and Mannings, for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants note that claims 20-27, 32, 34, 35 and 37 ultimately depend from independent claim 19, 31 or 33. As noted above, Yee clearly fails to anticipate claims 19, 31 or 33. Furthermore, Mannings clearly fails to remedy the deficiencies of Yee as applied against independent claims 19, 31 and 33. Accordingly, the combination of Yee and Mannings fails to render obvious dependent claims 20-27, 32, 34, 35 and 37.

For at least the foregoing reasons, Applicants respectfully submit that the obviousness rejection of claims 20-27, 32, 34, 35 and 37 should be withdrawn.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 19-37 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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